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PATENT & TRADEMARK OFFICE

EXPEDITED PROCEDURE – EXAMINING GROUP 2151

S/N 10/685,692 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Mark Anderson et al.	Examiner: K. Q Dinh
Serial No.:	10/685,692	Group Art Unit: 2151
Filed:	October 14, 2003	Docket No.: 2054.001US5
Title:	METHOD AND SYSTEM TO ASSOCIATE GEOGRAPHIC LOCATION INFORMATION WITH A NETWORK ADDRESS USING A COMBINATION OF AUTOMATED AND MANUAL PROCESSES	

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed January 18, 2006, from the Final Rejection of claims of the above-identified Application, as set forth in the Final Office Action mailed on September 2, 2005.

Pursuant to 37 C.F.R. 41.37(a), this Appeal Brief is submitted singly. The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of $500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request reconsideration and reversal of the Examiner's rejections of the pending claims.

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APPELLANTS' BRIEF ON APPEAL

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1. REAL PARTY IN INTEREST1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned Application is the Assignee, Quova, Inc.

2. RELATED APPEALS AND INTERFERENCES2. RELATED APPEALS AND INTERFERENCES

In accordance with 37 CFR §41.37(c)(1)(ii) requiring identification of all other appeals and interferences which would have any bearing on the Board's Decision in the present Appeal, to the best knowledge of Appellant, there have not been and are not any other Appeals, and no Interferences, based on the subject application.

3. STATUS OF THE CLAIMS

In accordance with 37 CFR § 41.37(c)(1)(iii) requiring a statement of the status of all claims, pending and cancelled, Appellant submits the following:

Claims 1-30 have been advanced during the prosecution history of the application. Claims 1-30 are therefore pending.

Claims 1, 2, 4-8, 12-16, and 18-22 stand finally rejected under 35 USC §102.

Claims 3, 11, and 17 stand finally rejected under 35 USC §103.

Claims 9, 10, 23, and 24 have been objected to as being dependent upon a rejected base claim.

The finally rejected claims meet the jurisdictional prerequisite under 37 CFR §1.191 for Appeal from the Decision of the Examiner to the Board of Patent Appeals and Interferences. In view of the requirements under 37 CFR §1.191 that an Appeal in an application or reexamination preceding identify, when the Appeal is taken, all rejected claim or claims which are to be appealed and proposed to be contested, Appellant respectfully submits that all presently rejected claims are appealed.

4. STATUS OF AMENDMENTS

The following is a statement of the status of any Amendments filed subsequent to final rejection (as required by 37 CFR §41.37(c)(1)(iv)).

No amendments have been made subsequent to the Final Office Action dated September 2, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the claimed embodiments defined in the claims in the Appeal, which refers to the specification by page and line number and to the drawings by reference characters (as required by 37 CFR §41.37(c)(1)(v))is detailed as follows.

A claimed embodiment includes a method to map a geolocation to a network address. Reference can be made to FIG. 9B and to independent claim 1 for illustration of a summarized embodiment.

The claimed embodiment includes a method to map a geolocation to a network address, the method including:

performing (92) at least one automated process to generate geolocation information for the network address;

determining (94) whether the at least one automated process generated satisfactory geolocation information for the network address; and

if the automated process did not generate satisfactory geolocation information for the network address, then forwarding (98) of the network address for manual resolution.

6. ISSUES PRESENTED FOR REVIEW

In accordance with 37 CFR §41.37(c)(1)(vi)), the following is a concise statement of each ground of rejection presented for review.

1) Whether claims 1, 2, 4-8, 12-16, and 18-22 are anticipated under 35 USC § 102(e) as being anticipated by Akatsu et al. (U.S. 6,523,064), where Akatsu et al. does not teach forwarding of the network address for manual resolution.

7. ARGUMENT

The contentions of Appellant with respect to the issue presented for review in the foregoing Item 6 and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on, (as required by 37 CFR §1.1 92(c)(8)), are provided as follows, with each issue being treated under a separate heading.

For each rejection under 35 USC § 102(e), Appellant's argument specifies (as required by 37 CFR 41.37(c)(1)(vii)) the errors in the rejection and why the rejected claims are patentable under 35 USC §102(e), including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

All descriptions of Appellant's disclosed and claimed embodiments, and all descriptions and rebuttal arguments regarding the applied references, as previously submitted by Appellant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the objections and rejections are respectfully traversed. Further, Appellant submits the following.

A) The Applicable Law

1) §102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless--

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ....

M.P.E.P. §2131, 8th Ed., Rev. 4 Anticipation – Application of 35 U.S.C. § 102(e)
"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

[A] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil of California, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) "The identical invention must be shown in as complete detail as is contained in the ... claim."

Richardson v. Suzuki Motor Co. 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Further, "the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." In re Brown, 141 USPQ 245, 249 (CCPA 1964). In particular, Brown repeats old law (1890) that

> the description must place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed. In order to accomplish this it must be so particular and definite that from it alone, without experiment or the exertion of his own inventive skill, any person versed in the art to which it appertains could construct and use it.

Id. at 249.

2) §103. Conditions for patentability; non-obvious subject matter

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (M.P.E.P. § 2143 8th Ed, Rev.4).

B)

1) ARGUMENT: The Claims are not Anticipated by Akatsu et al.

Claims 1, 2, 4-8, 12-16, and 18-22 stand finally rejected under 35 USC §102.

Appellant respectfully asserts that a method is claimed that requires "*forwarding* the network address for manual resolution" "if the automated process did not generate satisfactory geolocation information for the network address ..." (Claim 1, emphasis added).

The Final Office Action cites to Akatsu et al. at column 11, line 28 to column 12, line 58. There is no reference in this citation to forwarding for manual resolution "if the node unique ID is not found" (Akatsu at column 11, line 57), rather, there is only a automated reference to "then the node icon table is scanned for the desired node type" (Akatsu at column 11, line 58). This citation bears no reference to "forwarding the network address for manual resolution."

Because "each and every element as set forth in the claim is [not] found, either expressly or inherently described, in [Akatsu et al.]" (*Verdegaal Bros,* supra), Akatsu et al. does not anticipate the claim. Appellant notes that claims 2-14 depend from claim 1 and are therefore also not anticipated. Appellant respectfully requests the Board to overturn the Final Rejection status and to pass the claims to allowance.

Regarding claim 8, the Final Office Action cites to column 16, line 57 (Final Office Action at page 5), regarding a manual operation. But the scope of what Akatsu is performing is significantly different from what is claimed. Akatsu in the Abstract states "receiving a request, the request comprising a demand for information contained in the persistent data table." This recitation from Akatsu of having the request comprise "a demand for information" is significantly different from what is claimed of having the query include "a network address." Akatsu therefore does not anticipate dependent claim 8, "wherein the at least one automated process includes running an inexact geolocation process to generate the geolocation information for the network address."

Regarding independent claim 15, claim 15 also claims the limitation "if the geolocation information for the network address is not satisfactory, to forward the network address for manual resolution". Akatsu et al. does not teach this limitation and consequently does not anticipate claim 15. Appellant notes that claims 16-28 depend from claim 15 and are therefore also not anticipated. Appellant respectfully requests the Board to overturn the Final Rejection status and to pass the claims to allowance.

Regarding independent claim 29, claim 29 also claims the limitation "if the geolocation information for the network address is not satisfactory, to forward the network address for manual resolution". Akatsu et al. does not teach this limitation and consequently does not anticipate claim 29.

Regarding independent claim 30, claim 30 also claims the limitation "if the geolocation information for the network address is not satisfactory, to forward the network address for manual resolution". Akatsu et al. does not teach this limitation and consequently does not anticipate claim 30.

2) ARGUMENT: The Claims are not Unpatentable over Akatsu et al. in view of Zoken et al.

Claims 3, 11, and 17 stand finally rejected under 35 USC §103.

The Final Office Action admits that "Akastu does not specifically disclose an educational, business and government domain and a service provider." (Final Office Action at pages 6-7). Appellant agrees. But Zoken also does nothing to fill the void left by Akatsu, regarding the limitations of the independent claims that require "*forwarding* the network address for manual resolution" "if the automated process did not generate satisfactory geolocation information for the network address ..." (Claim 1, emphasis added). Because the cited references do not teach or suggest all the claims limitations, a *prima facie* case of obviousness has not been established. Appellant respectfully requests the Board to overturn the Final Rejection status and to pass the claims to allowance.

8. SUMMARY

Regarding the rejection of claims over 35 U.S.C. § 102(e), no method taught by Akatsu teaches the limitation of, *e.g.*, claim 1, "*forwarding* the network address for manual resolution" "if the automated process did not generate satisfactory geolocation information for the network address ..." (Claim 1, emphasis added).

Regarding the rejection of claims over 35 U.S.C. § 103(a), all the claim limitations are not taught in the cited references.

The Board is invited to telephone Appellant's attorney John Greaves at 801-278-9171 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MARK ANDERSON ET AL.

By their Representatives,

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Date April 24, 2006

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of April 2006.

Dawn R. Shaw

Name

Dawn R Shaw

Signature

CLAIMS APPENDIX

1. (Rejected) A method to map a geolocation to a network address, the method including:

   performing at least one automated process to generate geolocation information for the network address;

   determining whether the at least one automated process generated satisfactory geolocation information for the network address; and

   if the automated process did not generate satisfactory geolocation information for the network address, then forwarding of the network address for manual resolution.

2. (Rejected) The method of claim 1, wherein the at least one automated process includes determining whether the network address is likely to fall within a consolidated domain of network addresses maintained within a database of a geolocation system.

3. (Rejected) The method of claim 2, wherein the consolidated domain of network addresses maintained within the database includes any one of a group of domains including an educational, a business, a service provider and a government domain.

4. (Rejected) The method of claim 1, wherein the at least one automated process includes identifying a network address block around the network address.

5. (Rejected) The method of claim 1, wherein the at least one automated process includes running an exact geolocation process to generate the geolocation information for the network address.

6. (Rejected) The method of claim 4, wherein the at least one automated process includes running an exact geolocation process to generate the geolocation information for the identified network address block around the network address.

7. (Rejected) The method of claim 5, wherein the exact geolocation process includes any one of a group of geolocation processes including a traceroute, a latency calculation, a hostname matching operation and a DNS process.

8. (Rejected) The method of claim 1, wherein the at least one automated process includes running an inexact geolocation process to generate the geolocation information for the network address.

9. (Objected To) The method of claim 1, including performing a sequence of automated processes to generate the geolocation information for the network address, wherein the network address is advanced through the sequence of automated processes until the geolocation information for the network address is satisfactory, or until the network address is forwarded for manual resolution.

10. (Objected To) The method of claim 9, wherein the sequence of automated processes include both exact and inexact automated mapping operations, the exact and inexact automated mapping operations providing different levels of confidence for the geolocation information generated for the network address by the respective mapping operations.

11. (Rejected) The method of claim 1, wherein the network address is received from an external entity at a geolocation system, and a mapping process is initiated, at the geolocation system responsive to the receipt of the network address, to map the network address to a geolocation, wherein the query is received from the external entity responsive to a user accessing a website operated by the external entity, and the network addresses is a network address associated with a machine of the user.

12. (Rejected) The method of claim 1, wherein the network address is received as part of a query at a geolocation system, the query being received via an Application Program Interface (API).

13. (Rejected) The method of claim 1, wherein the network address is received as part of a query at a geolocation system, wherein the query is received via a customer extranet.

14. (Rejected) The method of claim 1, wherein the at least one automated process identifies a plurality of possible geolocations, and the manual process is to resolve amongst the plurality of possible geolocations.

15. (Rejected) A geolocation system to map a geolocation to a network address, the geolocation system including:

> a first system to receive a network address; and
>
> a second system to perform at least one automated process to generate geolocation information for the network address, to determine whether the geolocation information generated by the at least one automated process for the network address is satisfactory, and, if the geolocation information for the network address is not satisfactory, to forward the network address for manual resolution.

16. (Rejected) The geolocation system of claim 15, wherein the second system is to determine whether the network address is likely to fall within a consolidated domain of network addresses maintained within a database of the geolocation system.

17. (Rejected) The geolocation system of claim 16, wherein the consolidated domain of network addresses maintained within the database includes any one of a group of domains including an educational, a business, a service provider and a government domain.

18. (Rejected) The geolocation system of claim 15, wherein the second system is to identify a network address block around the network address included within the query.

19. (Rejected) The geolocation system of claim 15, wherein the at least one automated process includes running an exact geolocation process to generate the geolocation information for the network address.

20. (Rejected) The geolocation system of claim 18, wherein the at least one automated process includes running an exact geolocation process to generate the geolocation information for the identified network address block around the network address.

21. (Rejected) The geolocation system of claim 19, wherein the exact geolocation process includes any one of a group of geolocation processes including a traceroute, a latency calculation, a hostname matching operation and a DNS process.

22. (Rejected) The geolocation system of claim 15, wherein the at least one automated process includes running an inexact geolocation process to generate the geolocation information for the network address.

23. (Objected To) The geolocation system of claim 15, wherein the second system is to perform a sequence of automated processes to generate the geolocation information for the network address, wherein the network address is advanced through the sequence of automated processes until satisfactory geolocation information is associated with the network address, or until the network address is forwarded for manual resolution.

24. (Objected To) The geolocation system of claim 23, wherein the sequence of automated processes include both exact and inexact automated mapping operations, the exact and inexact automated mapping operations providing different levels of confidence for the geographic location information generated for the network address by the respective operations.

25. (Rejected) The geolocation system of claim 15, wherein the network address is received from an external entity at the geolocation system, and the second system is to initiate a mapping process, at the geolocation system responsive to the receipt of the network address, to map the network address to a geolocation, wherein the query is received from the external entity responsive to a user accessing a website operated by the

external entity, and the network addresses is a network address associated with a machine of the user.

26. (Rejected) The geolocation system of claim 15, wherein a query, including the network address, is received at the geolocation system via an Application Program Interface (API).

27. (Rejected) The geolocation system of claim 15, wherein a query, including the network address, is received via a customer extranet.

28. (Rejected) The geolocation system of claim 15, wherein the second system is to identify a plurality of geolocations, and to forward the plurality of geolocations for manual resolution amongst the plurality of geolocations.

29. (Rejected) A machine-readable medium storing a set of instructions that, when executed by a machine, cause the machine to perform a method to map a geolocation to a network address, the method including:

> performing at least one automated process to generate geolocation information for the network address;
>
> determining whether the geolocation information generated for the network address by the at least one automated process is satisfactory; and
>
> if the automated process did not generate satisfactory geolocation information for the network address, then forwarding of the network address for manual resolution.

30. (Rejected) A geolocation system to map a geolocation to a network address, the geolocation system including:

> first means for saving a network address; and

second means for performing at least one automated process to generate geographic_location information for the network address, for determining whether the geographic location information generated by the at least one automated process is satisfactory, and, if the automated process did not generate satisfactory geolocation information for the network address, for forwarding the network address for manual resolution.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

Application No. 10/686,102 is a Related Proceeding.